

Application No.: 10/800580
Amendment dated: September 2, 2008
Reply to Office action of May 8, 2008

REMARKS/ARGUMENTS

Claims 1 and 5 are pending.

Both claims have been rejected under 35 USC §112 on the ground that they do not comply with the written description requirement. Specifically, the Examiner has pointed to the claim language requiring that:

- (a) "substantially all of the fibers exposed on said wet paper web side surface are hydrophilic" and
- (b) "substantially all of the fibers exposed on said wet paper web side surface are. . . capable of holding an amount of water from a wet paper web in contact with the wet paper web side surface of the transfer belt sufficient to attach the wet paper web to the transfer belt for transfer of the wet paper web from the press part to a next stage in the papermaking machine.

The examiner asserts that the specification as originally filed "does not state" that "*substantially all* of the fibers exposed on said wet paper web side surface are hydrophilic," and that it does not provide support for the above-quoted limitation (b).

In reviewing limitation (b), it became apparent that the wording carried two possible unintended implications, namely the possibility that some fibers might be incapable of holding sufficient water, or that individual fibers hold sufficient water. Neither implication makes sense. The insertion of the words, "said exposed fibers are" makes it clear that the hydrophilic fibers as a group are capable of holding sufficient water.

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Section 2163 of the Manual of Patent Examining Procedure succinctly summarizes the case law on the written description requirement as follows: "To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention."

Newly added (or amended) claims must be supported in the specification through express, implicit, or inherent disclosure. But, there is no requirement that the new claims or added claim language be found in the original specification *in haec verba*. (MPEP, sec. 2163 (1)(B)), In re Wright, 866 F.2d 422, 425 (Fed. Cir. 1989). The applicable test is whether or not the disclosure reasonably conveys to one of skilled in the art that the inventor was in possession of the claimed subject matter at the time the application was filed. The same standards govern whether new matter has been added to the specification. TurboCare Div. of Demag Delaval Turbomachinery Corp. v. General Elec. Co., 264 F.3d 1111, 1118 (Fed. Cir., 2001).

"The PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims." In re Wertheim, 191 U.S.P.Q. 90, 97 (CCPA 1976).

First, the Examiner has not supplied evidence in support of the written description rejection, and has therefore not satisfied the evidentiary burden set forth in In re Wertheim.

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Second, insofar as limitation (a) is concerned, although the specification refers generally to a "hydrophilic fiber body," it is clear from the discussion of "hygroscopic" fibers in paragraph 0025 and the discussion of "fibers with hydrophilic treatments" in paragraph 0027, that the applicant's specification contemplates a fiber body made up of individual hydrophilic fibers. There is no doubt that a few stray exposed hydrophobic fibers could be present on the wet paper web side of the transfer belt without appreciably affecting the performance. This is the case in almost all multi-component compositions - a small amount of impurities or contaminants can be present without adverse effect. It is the possibility of a small number of hydrophobic fibers at the web side of the belt that the term "substantially" addresses. In other words, the phrase "substantially all of the fibers exposed on said wet paper web side surface are hydrophilic" means simply that the all or almost all of the exposed fibers are hydrophilic, allowing for a small number of hydrophobic fibers insufficient to exert an adverse effect on the performance of the belt that would be considered significant by a person of ordinary skill in the papermaking belt art. This is clearly what was intended in the original description, and clearly how it would have been understood by persons skilled in the art.

Third, insofar as limitation (b) is concerned, the amended version thereof is supported by the description in paragraphs 0011 and 0014. Paragraph 0011 describes the problem to be overcome by the invention: in the prior art, the wet paper web does not attach to the belt smoothly immediately after moving out

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of the press part. The belt actively breaks the water film, and the web can fail to attach to the surface of the belt. In the invention, as explained in paragraph 0014, the hydrophilic fibers hold water from the wet paper web, and therefore the web becomes attached reliably to the transfer belt and is removed smoothly from the belt when transferred to the next stage. When paragraph 0011 and 0014 are considered together, they essentially describe the limitation that the exposed fibers are capable of holding an amount of water from a wet paper web in contact with the wet paper web side surface of the transfer belt sufficient to attach the wet paper web to the transfer belt for transfer of the wet paper web from the press part to a next stage in the papermaking machine.

Concerning the rejection based on anticipation by Hagfors, it is the applicant's position that the interpretation of Hagfors as describing a belt with substantially all of its exposed fibers being hydrophilic is based on hindsight, taking advantage of Hagfors' vagueness to fit it to the Applicant's claims. The real question is: "what would a person of ordinary skill in the art understand from Hagfors' disclosure?" As mentioned in the previous response, the Office must interpret a prior art reference in the manner in which it would have been understood by a person skilled in the art. In re Paulsen, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994). Moreover, an inadvertent and unintended disclosure in a reference is not an anticipation if a person skilled in the art would perceive it as a mistake. Edison Electric Light Company v. Novelty Incandescent Lamp Co., 167 F.

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977 (3rd. Cir. 1909). In addition, the fact that Hagfors is primarily concerned with detachment should be taken into account in interpreting the content of Hagfors' disclosure and in determining how it would have been understood by one skilled in the art.

The declaration of Kenji Inoue, submitted herewith under 37 C.F.R. 1.132, points out that a person skilled in the art would have concluded that Hagfors' example 2 is in error. The declaration demonstrates that, despite the vagueness of Hagfors' description, a person skilled in the art of papermaking belts, would not understand Hagfors to describe anything other than a transfer belt having both hydrophilic and hydrophobic fibers exposed on the wet paper web contacting side.

That Example 2 contains an error is also evident from the absence of a specified linear density for the third group of "PA" fibers. Why, if Hagfors intended to specify three different groups of PA fibers, would he supply linear densities (dtex numbers) for the first two groups, and not say anything at all about the third group? The only plausible explanation is that the third group does not consist of PA fibers at all, but instead of other fibers, such as PE fibers the linear density of which doesn't matter.

There appears to be only one way to reconcile Hagfors' description of the "hydrophilic and hydrophobic" areas" as "formed by providing the fiber batt layer of the transfer belt with at least two fibres having different surface properties" with the description of the various surface properties using terms other than "hydrophilic" and "hydrophobic". Hagfors must

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mean that the "different surface properties," whatever they may be (polarity, electric charge, surface energy, friction properties or porosity) result in hydrophobicity in some of the fibers and hydrophilicity in the others.

In summary, the subject matter of the claims as presently amended is supported in the written description under the applicable standards, and is not described in Hagfors et al. The claims are therefore not subject to rejection on the grounds of lack of written description, or anticipation. Reconsideration and withdrawal of both grounds of rejection are respectfully requested.

Respectfully submitted,
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Enclosure:
declaration under Rule 132
request for extension